

RCE \$
2005

**REQUEST
FOR
CONTINUED EXAMINATION (RCE)
TRANSMITTAL**

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,
provides for continued examination of an utility or plant
application filed on or after June 8, 1995.
See The American Inventors Protection Act of 1999 (AIPA).

Application Number	10/630,982
Filing Date	July 31, 2003
Examiner Name	Frederick John Parker
First Named Inventor	James Dunman
Group Art Unit	1762
Attorney Docket Number	29953-184828

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.
NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

1. **Submission required under 37 C.F.R. § 1.114**

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on _____
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- iii. ☐ Other _____
- b. Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☒ Information Disclosure Statement (IDS)
- iv. ☐ Other _____

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☐ Other _____

3. **Fees** The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. **22-0261**
- i. ☒ RCE fee required under 37 C.F.R. § 1.17(e)
- ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
- iii. ☐ Other _____
- b. ☐ Check in the amount of \$ _____ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

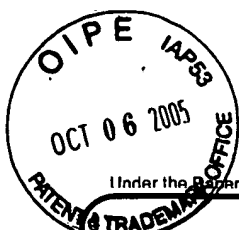
Name (Print /Type)	Stuart I. Smith	Registration No. (Attorney/Agent)	42,159
Signature		Date	October 6, 2005

VENABLE
P.O. Box 34385
Washington, DC 20043-9998

SEND Fees and Completed Forms to the following address: Commissioner for Patents, Box RCE, P.O. Box 1450, Alexandria, VA 22313-1450.
PC Docs No. 687814

10/07/2005 SZEWDIE1 00000145 220261 10630982

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PTO/SB/17 (12-04v2)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 790.00

Complete if Known

Application Number	10/630,982
Filing Date	July 31, 2003
First Named Inventor	James Dunman
Examiner Name	Frederick John Parker
Art Unit	1762
Attorney Docket No.	29953-184828

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 22-0261 Deposit Account Name: VENABLE LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	_____ / 50 = _____	(round up to a whole number) x _____	= _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): RCE Filing Fee

Fees Paid (\$)

\$790.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 42,159	Telephone 202 344-4683
Name (Print/Type)	Stuart I. Smith		Date October 6, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of:

James DUNMAN

Appl. No: 10/630,982

Confirmation No: 1857

Filed: July 31, 2003

For: METHOD FOR SHIELDING
CONTAINERS ON A COATING
LINE (as amended)

Art Unit: 1762

Examiner: Frederick John PARKER

Atty. Docket No: 29953-184828

Customer No:

26694

PATENT TRADEMARK OFFICE

REQUEST FOR RECONSIDERATION AFTER RCE UNDER 37 C.F.R. § 1.114

Mail Stop After Final

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

Sir:

In response to the Final Office Action dated July 6, 2005, Applicant hereby requests reconsideration of the final rejection in the above-identified application. This request is being filed concurrently with a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. Please charge any required fees, and debit any overpayment, to Deposit Account No. 22-0261. Reconsideration is respectfully requested in view of the following remarks.

I. Rejection under 35 U.S.C. § 112, First Paragraph

The Office Action finally rejects added claims 17-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses this rejection for at least the following reason.

Applicant respectfully submits that at least FIG. 1 provides support for the recitation in claims 17-20 that "the shields do not hold a threaded engagement portion of a finish of the containers." According to the Manual of Patent Examining Procedure (M.P.E.P.), an applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. M.P.E.P. § 2163(I); *see also, Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 U.S.P.Q.2d 1111, 1114 (Fed. Cir. 1991). ("drawings alone may provide a 'written description'

of an invention as required by Section 112”). In this case, FIG. 1 shows that the lower portion 10b of the shield 10 does not engage or hold the threaded portion of the container 18. Such engagement is unnecessary given that chuck 12 includes a plurality of springs 20, which retain the container 18 releasably, but securely from the inside (*see* specification, page 3, paragraph 7). In fact, the only portion of the shield 10 that engages the container 18 is shoulder 10d, which engages only the top of the container 18 and not the threaded portion thereof (FIG. 1; specification, page 3, paragraph 6).

Accordingly, Applicant respectfully requests that the rejection of claims 17-20 under section 112, first paragraph, be withdrawn. Furthermore, because claims 17-20 have not been rejected as being anticipated by or unpatentable over any prior art, Applicant respectfully submits that these claims are in condition for allowance.

II. Rejections under 35 U.S.C. § 103(a)

The Office Action finally rejects claims 1-4, 6, 8-12, 15, and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,740,259 to Carl et al (“Carl”) in view of U.S. Patent No. 4,667,620 to White. The rejection is respectfully traversed for at least the following three reasons.

First, the Office Action fails to make a *prima facie* case of obviousness because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference (Carl) or to combine the reference teachings to meet the limitations of the claimed method. The arguments presented in Applicant’s previous response dated May 23, 2005, at page 9, line 15 – page 10, line 3, are hereby incorporated by reference. Carl provides a method for masking the closeable area of a container 12 during the coating of the container 12 (*see* Carl, column 1, lines 16-19). The main body member 10 is provided with internal opening 11 adapted to receive and support the neck of a container 12 (Carl, column 3, lines 1-4). Importantly, Carl does not disclose or suggest that the main body member 10, which the Office Action equates to the recited shield, is “made from scraps of the first material produced from the making of the containers,” as recited in each of claims 1, 13, 15 and 16.

White, on the other hand, teaches a method and apparatus for making plastic containers 14 or 112 having decreased gas permeability by locating a vaporizing and ionizing source 22 proximate an open end of the container 14 or 112 for depositing a material on the interior surface of the container 14 or 112 (*see* White, column 2, lines 23-33). A magnet support 34 or 114 encompasses each container 14 or 112, respectively, and “if configured as a shield, prevents the deposit on the exterior of the bottles” (White, column 4, lines 50-59; *see also* column 3, lines 11-27). The Office Action cites White and ostensibly states that it would have been obvious to use “a polymeric masking body member of recycled scrap PET from the plastic container making process because White also discloses that PET can be recycled to be re-formed into articles” (Final Office Action, page 4, lines 13-15), in view of White’s brief discussion of container recycling at column 1, lines 63-68. White’s discussion of such recycling, however, is made in the context of describing the disadvantages of specific dip-coating techniques and that a new method of forming coated containers was needed to help ease recycleability thereof. The Applicant respectfully submits that this brief discussion of recycling does not teach why one would be motivated to make shields from scraps of material produced during the making of the containers for coving portions of other containers during coating.

Second, even assuming, *arguendo*, that the combination of Carl and White is proper, the combination fails to teach all of the claim limitations (*see* Applicant’s previous response dated May 23, 2005, at page 10, lines 3-6). As to each of claims 1, 13, 15 and 16, Carl fails to teach shields made from scraps of the first material produced from the making of the containers, for at least the same reasons presented above. White, as cited by the Office Action, does not cure this deficiency in Carl for at least the same reasons presented above.

Additionally, with regard to claim 15, Carl fails to teach shields removably held on the conveyor by a friction fit. The chuck apparatus main body member 10 of Carl, which the Office Action interprets as a shield, is not disclosed as being removably held on a conveyor, let alone by a friction fit. White does not cure this deficiency.

Similarly, with regard to claim 16, Carl fails to teach shields removed from the conveyor and disposed of during shutdown. The chuck apparatus main body member 10 of

Carl, which the Office Action interprets as a shield, is not disclosed as being removably held on a conveyor, let alone capable of being disposed of during a shutdown. As above, White does not cure this deficiency.

Third, the Office Action uses impermissible hindsight reconstruction based on Applicant's disclosure. The Office Action expressly states that "the use of production scrap to make the polymeric masking body would have provided an opportunity to re-form container scrap into a useful product used in container production, resulting in apparent economic benefits" (Final Office Action, page 4, lines 15-17). Applicant respectfully submits that neither one of Carl nor White discloses or teaches the use of scraps of the first material produced from the making of the containers to make the shields and that the foregoing conclusion only arises in hindsight from reading Applicant's disclosure. Claims 2-4, 6, 8-11, and 17-20 depend from at least one of claims 1, 13, 15 and 16, and, therefore, are submitted as being allowable for at least the same reasons. Withdrawal of the rejection is respectfully requested.

The Office Action also finally rejects claims 5, 7, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Carl in view of White, and further in view of "Admitted Prior Art". The rejection is respectfully traversed since claims 5, 7, 13, and 14 depend from at least one of claims 1, 13, 15 and 16, and, therefore, are submitted as being allowable for at least the same reasons. Withdrawal of the rejection is respectfully requested.

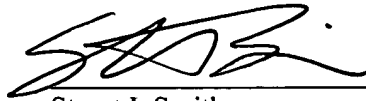
III. Conclusion

In sum, Carl and White, either alone or in combination, fail to render obvious the present claims because: 1) there is no suggestion or motivation to combine the references; 2) the references, either alone or in combination, fail to teach or suggest all of the claim limitations; and 3) the Office Action uses impermissible hindsight reconstruction. In light of the above remarks and those presented in Applicant's previous response dated May 23, 2005, it is submitted that claims 1-11 and 13-20 are allowable. Reconsideration of the rejection and the issuance of a Notice of Allowance are respectfully requested.

Applicants: James DUNMAN
Application No.: 10/630,982

Respectfully submitted,

Date: October 6, 2005

A handwritten signature in black ink, appearing to read "Stuart I. Smith", is written over a horizontal line.

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